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CHOATE, HALL & STEWART LLP
TWO INTERNATIONAL PLACE
BOSTON MA 02110

In re Application of	:
MANALIS et al.	: DECISION ON
Application No. 10/669,883	: RENEWED PETITION
Filed: September 23, 2003	: UNDER 37 CFR 1.78
Attorney Docket No. 0492611-0510	:

This is a decision on the "Petition to Claim Priority", filed 21 November 2006, to accept an unintentionally delayed claim under 35 U.S.C. §§119(e) and 120 for the benefit of the prior-filed provisional and nonprovisional applications set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

On 16 March 2006, a decision dismissing applicant's petition under 37 CFR 1.78 was mailed to applicant indicating that applicant had failed to (1) clearly identify the intermediate nonprovisional application as claiming benefit to the provisional application and (2) make the proper statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the above-noted, prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and (5)(ii). Therefore, this is a proper petition under 37 CFR 1.78.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) and (a)(5) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). In addition, the petition under 37 CFR 1.78(a)(3) and (a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) and 1.78(a)(5)(i) of prior filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) and (a)(6) in that (1) a reference to the prior-filed nonprovisional and provisional applications has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii) and (a)(5)(iii) and (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted.

Applicant provided a statement of unintentional delay. However, applicant delayed in filing the renewed petition until 21 November 2006, over 8 months after the mailing of the 16 March 2006 decision. It is noted that applicant took other actions in this application; that is, on 1 August 2006, applicant filed, *inter alia*, an amendment to the claims. But applicant appeared to delay in responding to the 16 March 2006 decision, which set out precisely what was required to submit a grantable petition. 37 CFR 1.78(a)(3)(iii) and (a)(6)(iii) clearly states that "The Director may require additional information where there is a question whether the delay was unintentional."

Accordingly, before the petition under 37 CFR § 1.78 can be granted, a renewed petition under 37 CFR § 1.78 including an explanation for the lengthy delay between the mail date of the Decision of 16 March 2006 and the filing of the renewed petition on 21 November 2006 is required.

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Cynthia Kratz at (571) 272-3286.



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